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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,071	07/13/2005	Reinhold Ott	40770-000167/US	9681

30593 7590 12/29/2008

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 8910
RESTON, VA 20195

EXAMINER	
PREVIL, DANIEL	

ART UNIT	PAPER NUMBER
2612	

MAIL DATE	DELIVERY MODE
12/29/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/542,071	OTT, REINHOLD	
	Examiner	Art Unit	
	DANIEL PREVIL	2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 September 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5-10 and 12-68* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-10,13 and 15-68* is/are rejected.

7)☐ Claim(s) *12 and 14* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to communication filed on September 5, 2008.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-3, 5-10, 12-68 of Application 10/542,071 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 8, 35, 38 of copending Application No. 10/543,088. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are arguably broader than claims 1, 8, 35, 38 of Application 10/543,088 which encompasses the same metes, bounds and limitations. Therefore, it would have been obvious to eliminate the limitations of the narrower claims, since it has been held that omission of an element and its function and a combination where the

remaining elements perform the same functions as before involves only routine skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5,7, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 5, the phrase “it” in line 2, renders the claim vague and indefinite.

Claim 7 is rejected for the same reason, since it depends from a rejected claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-3, 6, 8-10, 13, 15-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hammond et al. (US 6,686,840) in view of Brinkmeyer et al. (US 2001/0028295).

Regarding claims 1-3, 6, 8-10, 13, 15-18, Hammond discloses method for protecting a commercial product against theft (abstract) the method comprising: activating a receiver housed in a security unit, the security unit thereby being in an on-state mode (receiver 36 in alarm housing 32 in fig. 2, col. 3, lines 31-45); shifting the security unit from the on-state mode to a connect mode for connecting the commercial product to the security unit, the shifting occurring when the receiver is impinged upon by a transmitter (transmission unit 12 sends RF signals to receiver 36 to lock purse 54 in fig. 1-fig. 3; col. 4, lines 58-61).

Hammond discloses all the limitations above but fails to explicitly disclose wherein the receiver is deactivated when the security unit shifts to the connect mode.

However, Brinkmeyer discloses wherein the receiver is deactivated when the security unit shifts to the connect mode (page 3, [0029]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Brinkmeyer's receiver is deactivated into Hammond's system in order to accurately detects theft attempts thereby increasing the safety of the system.

Regarding claim 19, Hammond discloses CPU 34 (FIG. 3B) wherein volatile memory is inherently included in the CPU 34 (fig. 3B).

Regarding claims 20-22, Hammond discloses wherein to transmit the selection signal from the transmitter to the receiver, a remote operation system (abstract; col. 3, lines 61-64).

Regarding claims 23-24, Hammond discloses at least one of an optical and acoustic signal (col. 3, lines 40-45).

Regarding claims 25-26, Hammond discloses an energy source for the security unit (battery in col. 3, line 30).

Regarding claim 27, Hammond discloses multiple security units using a single transmitter (fig. 3).

Regarding claims 28-34, Hammond discloses the security unit is equipped with a bracket component for mounting to the product and wherein, in attaching the bracket component to the product, a monitoring of the bracket component for proper attachment to the product is activated (fig. 2; col. 4, lines 19-65).

7. Claims 35-37, 39, 41-44, 52-58, 61, 63-68 rejected under 35 U.S.C. 103(a) as being unpatentable over Howell (US 5,955,948) in view of Brinkmeyer et al. (US 2001/0028295).

Regarding claims 35, 36, 39, 55, Howell discloses device for protecting a commercial product against theft (fig. 1; abstract) comprising: a security unit including an on-state mode in which a receiver housed in the security unit is activated (col. 2,

lines 2-32; col. 4, lines 46-51); wherein the security unit is placed in the on-state mode when it is switched on (fig. 1; col. 5, lines 33-52).

Howell discloses all the limitations above but fails to explicitly disclose connect mode in which the receiver is deactivated.

However, Brinkmeyer discloses connect mode in which the receiver is deactivated (page 3, [0029].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Brinkmeyer's connect mode in which the receiver is deactivated into Howell's system in order to preclude articles from being stolen thereby improving the safety of the system.

Regarding claim 37, Howell discloses wherein the security unit is preparable, in the connect mode for a shift to the monitoring mode (col. 2, lines 2-31; col. 5, lines 33-52).

Regarding claims 41-44, 52-54, 56-58, 63-67, Howell discloses wherein the security unit includes a bracket component for attachment to the product (fig. 1; fig. 2).

Regarding claim 68, Howell discloses wherein the mounting component and the bracket component are coupleable via a magnet (fig. 1; fig. 2).

Regarding claim 48, Howell discloses at least one of optical and acoustic signal generators (audible alarm in abstract).

Regarding claim 61, Howell discloses wherein the receiver is housed in at least one of the mounting component and the central unit (fig. 1; fig. 2).

8. Claims 38, 40, 45-46, are rejected under 35 U.S.C. 103(a) as being unpatentable over Howell (US 5,955,948) in view of Brinkmeyer et al. (US 2001/0028295).

Regarding claims 38, 45, Howell discloses a device for protecting a product against theft (abstract, fig. 1), comprising: a security unit connected to a central unit via connectors (fig. 1); the central unit including a connect mode and an on-state mode (col. 2, lines 9-32; col. 4, lines 35-60), a receiver housed in the central unit being activated in the on-state mode (col. 2, lines 15-32); wherein the security unit is placed in the on-state mode when it is switched on (col. 5, lines 33-52).

Howell discloses all the limitations above but fails to explicitly disclose deactivated in the connected mode.

Howell discloses all the limitations above but fails to explicitly disclose deactivated in the connect mode.

However, Brinkmeyer discloses deactivated in the connect mode (page 3, [0029]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Brinkmeyer's deactivated in the connect mode into Howell's system in order to preclude articles from being stolen thereby improving the safety of the system.

. Regarding claim 40, Howell discloses wherein at least one of the security unit and the central unit is preparable, in the connect mode for a shift to the monitoring mode (fig. 1-fig. 2; col. 5, lines 33-52).

Regarding claim 46, Howell discloses wherein a transmitter, designed as a remote operation system is provided for impinging upon the receiver (fig. 1-fig. 215-32).

9. Claims 47, 49-51, 59-60, 62, are rejected under 35 U.S.C. 103(a) as being unpatentable over Howell in view of Brinkmeyer as applied to claim 38 above, and further in view of D'Angelo.

Regarding claim 47, Howell and Brinkmeyer disclose all the limitations set forth in claim 35 but fail to explicitly disclose a volatile memory for storing a selection signal.

However, D'Angelo discloses wherein at least one of the security unit and the central unit includes a volatile memory for storing a selection signal (fig. 1 ; col. 4, lines 29-47). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate D'Angelo's volatile memory into Howell and BrinKmeyer's system in order to save valuable information within the system; thereby improving the efficiency of the system.

. Regarding claims 49-50, Howell and Brinkmeyer disclose all the limitations set forth in claim 35 and D'angelo further discloses "light emitting diodes and piezoelectric transducers" (col. 7, lines 33-37). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate D'Angelo's light emitting diodes and piezoelectric transducers into Howell and Brinkmeyer's system in order to provide low power consumption and sufficient brightness for the intended purpose. Thereby, ensuring more reliable data transmission for the benefice of the users.

Regarding claims 51,59-60, Howell and Brinkmeyer disclose all the limitations set forth in claim 35 and D'Angelo further discloses a housing of at least one of the security unit and the central unit is at least partially translucent or transparent (adhesive in col. 2, lines 21-26). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate D'Angelo's partially transparent into Howell and Brinkmeyer's system in order to determine an accurate attachment; thereby, ensuring more reliable data transmission for the benefice of the users.

Regarding claim 62, Howell and Brinkmeyer disclose all the limitations set forth in claim 43 and D'Angelo further discloses wherein a battery chamber is provided in at least one of the mounting component and the central unit (col. 6, lines 56-58). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate D'Angelo's battery chamber into Howell and Brinkmeyer's system in order to save efficiently energy; thereby improving the performance of the system.

Allowable Subject Matter

10. Claims 12, 14, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: In combination with all the limitations in the claim, the prior arts fail to teach or make obvious: wherein the security unit is shifted from the connect mode to an alarm mode if

it is not prepared within a preset time interval for a shift to the monitoring mode and wherein the receiver is activated when the security unit shifts to the alarm mode.

Response to Arguments

11. Applicant's arguments with respect to claims 1-3, 5-10, 12-68 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Matsudaira (US 6,043,744) discloses antitheft system.

Ireland et al. (US 7,015,814) discloses security tag.

Olah (US 5,396,218) discloses a portable security system using communicating cards.

Drori (US 5,650,774) discloses electronically programmable remote control access system.

Farrar et al. (US 4,686,513) discloses electronic surveillance using self- powered article attached tags.

Russo et al. (US 5,640,144) discloses an RF/ultrasonic separation distance alarm.

Shaughnessy (US 4,027,276) discloses transmitter for a coded electronic security system.

Enkelmann (US 4,851,815) discloses a device for the monitoring of objects and/or persons.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL PREVIL whose telephone number is (571)272-2971. The examiner can normally be reached on Monday-Thursday. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin Lee can be reached on (571) 272-2963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DP
December 14, 2008.

/Daniel Previl/
Examiner, Art Unit 2612